

**REMARKS**

This Amendment is responsive to the Office Action mailed on July 5, 2006. Claims 1-3, 12-15, 18-21, 25, 26, and 28 are amended. Claims 5, 6, and 27 are cancelled. Claims 29 and 30 are new. Claims 1-4, 7-26, and 28-30 are pending.

The Examiner has objected to the Abstract. The Abstract is amended herein to overcome the Examiner's objection, withdrawal of which is respectfully requested.

Claims 1-4, 7, 8, and 23-25 are rejected under 35 U.S.C. § 102(b) as being anticipated by Polkowski (US 743,658).

Claims 1-4, 7, 8, and 16-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Howard (US 4,333,235) in view of Willard (US 5,168,629).

Claims 5 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Polkowski or Howard in view of Nishikawa (US 4,250,620).

Claims 9 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Polkowski or Howard in view of Rauh (US 2,078,585).

Claims 27 and 28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Polkowski or Howard in view of Hamann (US 434,595).

Applicants respectfully traverse these rejections in view of the amended claims and the following comments.

**Discussion of Amended Claims**

Claim 1 is amended to include the subject matter of claims 5, 6 and 27. Claim 1 is further amended to specify that the first handle part and the second handle part each have an ergonomically shaped hand-abutment region (See, e.g., Applicant's specification, page 11, second paragraph and page 13, third paragraph). Claim 1 is also amended for clarity and to improve readability.

Claims 5, 6, and 7 are cancelled to avoid duplication of claimed subject matter.

Claims 2, 3, 12-15, 18-21, 25, 26, and 28 are amended for clarity, to improve readability,

and to overcome potential antecedent basis problems.

New claim 29 specifies that the hand-abutment region of the first handle-part has a positioning cavity for a user's forefinger (See, e.g., Applicant's specification, page 13, third paragraph).

New claim 30 specifies that the positioning cavity is bounded by a protuberance forming an abutment surface for the user's middle finger (See, e.g., Applicant's specification, page 13, third paragraph).

Applicant's invention as set forth in claim 1 is related to a run-through shears designed so that a user's hand is located at a distance from the workpiece during cutting. The first handle part and the second handle part are respectively disposed in an angled manner relative to the shear heads to achieve this goal. Because of this arrangement of the handle parts in an angled manner relative to the shears head, for the portion between the respective handle parts and the shears head more material is required. Thus, for example, transition regions 52 and 70 are needed (see, e.g., Applicant's specification, page 11, line 23 and page 13, line 9). By manufacturing the handle parts and the shear-head limbs from a plastic material, the overall weight of the run-through shears can be minimized. This results in lighter run-through shears which are easier for an operator to use.

In addition, with Applicant's invention according to claim 1, the cutting blades are separately produced parts which are not involved in the formation of the rotary bearing. It is therefore possible to separate the cutting function from the mechanical function with regard to the mounting the handle-part/shears-head limb combinations on one another. This allows separate optimization. It is thus possible to produce the cutting plates from thin sheet-metal parts, which are sufficient in principle for the cutting action.

Accordingly, with Applicant's claimed invention there is no need to provide a forged shears head.

Further, since the first handle part and the second part each both have an ergonomically shaped hand-abutment region, the run-through shears are easier to use since a user can exert higher forces. For example, such run-through shears can be used for cutting tin.

Also, with a compression spring disposed between the two handle-parts/shears-head limb combinations which opens the shears head in the non-loaded state, the run-through shears are easy to use. With the spring, the shears head is opened automatically if the user does not exert a force.

#### Discussion of Polkowski

Claims 1-4, 7, 8, and 23-25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Polkowski. This rejection is respectfully traversed. An anticipation rejection requires that each and every element of the claimed invention as set forth in the claim be provided in the cited reference. See *Akamai Technologies Inc. v. Cable & Wireless Internet Services Inc.*, 68 USPQ2d 1186 (CA FC 2003), and cases cited therein. As discussed in detail below, Polkowski does not meet the requirements for an anticipation rejection.

The Examiner has rejected independent claim 1 in view of Polkowski. Applicant has amended claim 1 herein to include the subject matter of claims 5, 6, and 27

Polkowski discloses tailor's shears, and not run-through shears as claimed by Applicant. This can be seen from Figures 1 to 3 of Polkowski. When a sheet material is to be cut, the handle portions a2 and b2 of Polkowski will be on different sides of the sheet material. For example, the handle part a2 be above the sheet material and the handle part b2 will be below the sheet material. In particular, the handle part a2 of Polkowski is not disposed in an angled manner relative to a shears head (e.g., body portion d of Polkowski).

Further, Polkowski does not disclose or remotely suggest that the handle parts and the shears-head limbs are made from a plastics material, as acknowledged by the Examiner (Office Action, page 5). The Examiner relies on Nishikawa as disclosing shears with a plastic handle and plastic shears head in rejecting claims 5 and 6 (the subject matter of which is now included in amended claim 1). Nishikawa discloses lightweight plastic safety scissors and not run-through shears. In particular, Nishikawa does not disclose that the the first handle part and the second handle part are respectively disposed in an angled manner relative to the shears head so that a

user's hand is located at a distance from a workpiece during cutting. Thus, there would have been no motivation for one skilled in the art to look to Nishikawa when attempting to improve the design of run-through shears.

Further, Applicant respectfully submits that Nishikawa does not disclose or remotely suggest that the cutting blades are individual parts which are fixed on respective cutting-blade retaining regions of the associated plastic shears-head limbs, and the parts forming the cutting blades are spaced away from the rotary bearing, as set forth in Applicant's amended claim 1. In contrast, in Nishikawa, the plastic material of the entire blade portions 18 are formed by injection molding of plastic around the cutting blades 1 (Col. 2, lines 22-54). Thus, in Nishikawa, the blade 1 is not fixed on a respective cutting blade retaining region of the associated shear-head limb as claimed by Applicant, but rather formed integral with the entire shears head limb. Further, the cutting blade 1 of Nishikawa includes a pivot hole 4 for receiving the pivot pin 9 (Col. 2, lines 49-50). Thus, in Nishikawa, the parts forming the cutting blades are not spaced away from the rotary bearing, but instead actually form the pivot hole for receipt of the pivot pin (which in Nishikawa takes the place of a pivot bearing). Accordingly, if one skilled in the art were somehow motivated to combine the disclosures of Polkowski and Nishikawa, one skilled in the art would arrive at a set of tailor's shears formed of injection molded plastic around metal cutting blades which blades extend the entire length of the shears head limbs and where the blades includes a pivot hole for a pivot pin. Such a device would not meet the limitations of Applicant's amended claim 1.

Further, the tailor's shears of Polkowski do not have a first handle part and a second handle part each having an ergonomically shaped hand-abutment region, as claimed by Applicant. Rather, in Polkowski, the handle portion a2 comprises a loop for a user's thumb and the handle portion d2 comprises a loop for one or more fingers of the user.

Further, Polkowski does not disclose or remotely suggest that a compression spring is disposed between the two handle-part/shears-head-limb combinations, said spring opening the shears head in a non-loaded state, as acknowledged by the Examiner (Office Action, page 7). The Examiner relies on Haman as teaching the use of a compression spring in rejecting claim 27 (the

subject matter of which is now included in amended claim 1). Hamann discloses a pruning implement and not run-through shears. In particular, Hamann does not disclose that the the first handle part and the second handle part are respectively disposed in an angled manner relative to the shears head so that a user's hand is located at a distance from a workpiece during cutting.

Thus, there would have been no motivation for one skilled in the art to look to Hamman when attempting to improve the design of run-through shears.

Further, Haman does not disclose or remotely suggest that the handle parts and shears-head limbs are made from a plastics material. Moreover, Haman does not disclose or remotely suggest that a first handle part-shears-head-limb-combination and a second handle-part/shears-head limb combination are formed. Also, Haman does not disclose or remotely suggest that the cutting blades are individual parts which are fixed on cutting-plate retaining regions.

As Polkowski does not disclose each and every element of the invention as claimed in amended claim 1, the rejections under 35 U.S.C. § 102(b) are believed to be improper, and withdrawal of the rejections is respectfully requested. See, *Akamai Technologies Inc., supra*.

Applicants respectfully submit that the present invention is not anticipated by and would not have been obvious to one skilled in the art in view of Polkowski, taken alone or in combination with any of the other prior art of record.

Withdrawal of the rejections based on Polkowski under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) is therefore respectfully requested.

#### Discussion of Rejections Based on Howard Under 35 U.S.C. § 103(a)

Claims 1-4, 7, 8, and 16-26 are rejected as being unpatentable over Howard in view of Willard. Claim 1 is amended herein to include the subject matter of claims 5, 6, and 27.

Howard discloses cross-scissors/shears with upwardly offset handles so that both handles are above the material being cut (Abstract).

Howard does not disclose or remotely suggest that a first handle part and a second handle part have an ergonomically shaped hand-abutment region. In Howard, one handle has a hole 18

for a user's thumb and the other handle has a hole 18 for a plurality of fingers of a user (Col. 1, line 67 through Col. 2, line 2).

Further, Howard does not disclose or remotely suggest that the handle parts and the shears-head limbs are made from a plastics material, as acknowledged by the Examiner (Office Action, page 5). The Examiner relies on Nishikawa as disclosing shears with a plastic handle and plastic shears head in rejecting claims 5 and 6 (the subject matter of which is now included in amended claim 1). Nishikawa discloses lightweight plastic safety scissors and not run-through shears. In particular, Nishikawa does not disclose that the the first handle part and the second handle part are respectively disposed in an angled manner relative to the shears head so that a user's hand is located at a distance from a workpiece during cutting. Thus, there would have been no motivation for one skilled in the art to look to Nishikawa when attempting to improve the design of run-through shears.

Further, Applicant respectfully submits that Nishikawa does not disclose or remotely suggest that the cutting blades are individual parts which are fixed on respective cutting-blade retaining regions of the associated plastic shears-head limbs, and the parts forming the cutting blades are spaced away from the rotary bearing, as set forth in Applicant's amended claim 1. In contrast, in Nishikawa, the plastic material of the entire blade portions 18 are formed by injection molding of plastic around the cutting blades<sup>1</sup> (Col. 2, lines 22-54). Thus, in Nishikawa, the blade 1 is not fixed on a respective cutting blade retaining region of the associated shear-head limb as claimed by Applicant, but rather formed integral with the entire shears head limb. Further, the cutting blade 1 of Nishikawa includes a pivot hole 4 for receiving the pivot pin 9 (Col. 2, lines 49-50). Thus, in Nishikawa, the parts forming the cutting blades are not spaced away from the rotary bearing, but instead actually form the pivot hole for receipt of the pivot pin (which in Nishikawa takes the place of a pivot bearing). Accordingly, if one skilled in the art were somehow motivated to combine the disclosures of Howard, Willard, and Nishikawa, one skilled in the art would arrive at either the scissor assembly of Willard or the cross scissors of Howard formed of injection molded plastic around metal cutting blades which blades extend the entire

length of the shears head limbs and where the blades includes a pivot hole for a pivot pin. Such a device would not meet the limitations of Applicant's amended claim 1.

In addition, Howard does not disclose or remotely suggest that a compression spring is disposed between the two handle-part/shears-head-limb combinations, said spring opening the shears head in a non-loaded state, as acknowledged by the Examiner (Office Action, page 7). The Examiner relies on Haman as teaching the use of a compression spring in rejecting the subject matter of claim 27 (the subject matter of which is now included in amended claim 1). Hamann discloses a pruning implement and not run-through shears. In particular, Hamann does not disclose that the the first handle part and the second handle part are respectively disposed in an angled manner relative to the shears head so that a user's hand is located at a distance from a workpiece during cutting. Thus, there would have been no motivation for one skilled in the art to look to Hamman when attempting to improve the design of run-through shears.

Further, Haman does not disclose or remotely suggest that the handle parts and shears-head limbs are made from a plastics material. Moreover, Haman does not disclose or remotely suggest that a first handle part/shears-head-limb-combination and a second handle-part/shears-head limb combination are formed. Also, Haman does not disclose or remotely suggest that the cutting blades are individual parts which are fixed on cutting-plate retaining regions.

Still further, Howard does not disclose or remotely suggest that cutting blades are individual parts which a fixed on cutting-plate retain regions and are spaced away from the rotary bearing, as acknowledged by the Examiner (Office Action, page 4). The Examiner relies on Willard as disclosing individual cutting blade parts. Applicant respectfully submits that Willard does not disclose run-through shears. In particular, Willard does not disclose that the the first handle part and the second handle part are respectively disposed in an angled manner relative to the shears head so that a user's hand is located at a distance from a workpiece during cutting. Thus, there would have been no motivation for one skilled in the art to look to Willard when attempting to improve the design of run-through shears.

Further, Willard does not disclose or remotely suggested that the scissors comprise a first handle part and a second handle part each having an ergonomically shaped hand-abutment

region. To the contrary, Willard is related to scissors that can be manipulated with the palm and the thumb (Col. 2, lines 11 - 14) which is in clear contrast to the Applicant's claimed invention, where each handle part has an ergonomically shaped hand abutment region.

It is to be noted that Applicant's invention is directed towards run-through shears in which the first handle part and the second handle part are arranged in an angled manner relative to the shears head so that the user's hand is located at a distance from the material being cut. Thus, with such run-through shears the user's cutting hand does not come into contact with the material being cut and is protected from the cut material. The only prior art document that discloses this feature of Applicant's claimed invention is Howard, and as discussed in detail above Howard does not disclose or suggest many of the other limitations of Applicant's amended independent claim 1. The remaining prior art relied on by the Examiner (i.e., Polkowski, Willard, Hamann, Rauh, and Nishikawa) is not directed to run-through shears of the type claimed by Applicant. Only with hindsight impermissibly gained from Applicants' disclosure could one of ordinary skill in the art have arrived the conclusions reached by the Examiner.

Applicants respectfully submit that the present invention is not anticipated by and would not have been obvious to one skilled in the art in view of Howard, taken alone or in combination with Willard or any of the other prior art of record.

Withdrawal of the rejections based on Howard under 35 U.S.C. § 103(a) is therefore respectfully requested.

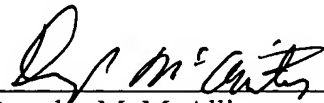
Further remarks regarding the asserted relationship between Applicant's claims and the prior art are not deemed necessary, in view of the amended claims and the foregoing discussion. Applicants' silence as to any of the Examiner's comments is not indicative of an acquiescence to the stated grounds of rejection.



Conclusion

The Examiner is respectfully requested to reconsider this application, allow each of the pending claims and to pass this application on to an early issue. If there are any remaining issues that need to be addressed in order to place this application into condition for allowance, the Examiner is requested to telephone Applicants' undersigned attorney.

Respectfully submitted,



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